

Application No. 10/811,102
Amendment A dated June 8, 2006
Reply to Office Action mailed January 24, 2006

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed January 24, 2006. Claims 2, 14, 15, 22, and 26 are amended and new claims 27 and 28 are added. Claims 1-28 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. Allowed Subject Matter

The Examiner has indicated that claim 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicants have rewritten claim 14 in an independent format so as to include all of the limitations of the base claim. In particular, the scope of claim 14 has not been narrowed in any way so as to overcome any prior art, but has merely been rewritten in an independent format. As acknowledged by the Examiner, claim 14 is patentably distinct from the prior art, and is now in a condition for allowance.

II. CLAIM REJECTIONS

A. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1-13 and 15-26 under 35 U.S.C. § 103 as being unpatentable over *Willner et al.* (U.S. Patent No. 5,546,209) and *Yamashita et al.* (U.S. Patent No. 4,737,946) in view of *Shulze et al.* ("Erfinder" means "Inventor" in German) (WO 00/46620). The applicant

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traverses the rejection of claims 1-13 and 15-26 at least for the reasons that the Examiner has failed to set forth a proper *prima facie* case of obviousness, the Examiner has not set forth where the references teach and suggest each and every element of claims 1-13 and 15-26, and because the motivation/suggestion for the combination of references is insufficient for the proposed combination of references.

On the outset, the Applicant requests an English translation of WO 00/46620 to *Shulze et al.* MPEP § 706 sets forth procedures to be followed by the PTO when rejecting claims. MPEP § 706.02 II (reproduced below) sets forth the procedure to be followed when the PTO relies upon abstracts and foreign language documents in support of a reference. More specifically, MPEP § 706.02 II sets forth the following:

If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP § 706.07(a).

MPEP § 706.02 II (emphasis added).

The Applicant requests that the rejection of claims 1-13 and 15-26 be withdrawn because evidence set forth in the Office Action has not been clearly explained and is too cursory to carry the Patent Office's burden to set forth a *prima facie* case of obviousness. "In rejecting claims for

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want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 CFR 1.104 (emphasis added). Moreover, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." MPEP 706.

The Office Action includes a vague and conclusory rejection of the claims without setting forth the particular parts of the references relied upon in support of such assertions made therein. In effect, the Examiner has tried to require the Applicant to search the references for the elements of the claims to determine whether they exist in the references, which does not satisfy the Examiner's duty to set forth a *prima facie* case of obviousness. In particular, the rejection merely makes a vague reference to what *Willner* and *Yamashita* teach without citing the particular part of the references relied upon to the specificity required by applicable statute, case law, and the MPEP. For the Applicant to have the opportunity to completely respond, the Examiner must clearly articulate the rejection. The PTO must point to concrete evidence in the record in support of the findings. *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added; footnote omitted).

What follows is a discussion of the analysis required for the Patent Office to provide a *prima facie* case of obviousness. According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to

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show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

Therefore, the rejection should be withdrawn because it fails to follow the required analysis.

Applicants also traverses the Examiner's rejection because the Examiner has not set forth where all of the claimed elements are taught or suggested by the references. For example, claim 1 recites the element, "wherein the at least two electrooptical components each are in an optical free-beam connection with the same waveguide by means of at least one lens." (Emphasis added). The Examiner has not set forth where the "at least one lens" element is taught or suggested by the references in combination with all of the other elements of claim 1 and configured as set forth therein. Therefore, the rejection of claim 1 should be withdrawn. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, the rejection of claims 2-13 and 15-26 should be withdrawn at least for the same reasons as claim 1.

Applicants also traverse the Examiner's rejection for obviousness on the grounds that the Examiner's recited motivation is improper. The prior art must teach or suggest making a modification to the prior art in order to render a claimed invention obvious. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In other words, one must be motivated by the prior art to make the modification necessary to arrive at the present invention. *In re Vaeck*, 947 F.2d 488,

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493 (Fed. Cir. 1991). Absent such motivation, a rejection based on a combination of references is unsupported and any rejection based on such a combination must be withdrawn.

According to the Examiner, "optical free-beam connection is very well known in this art." It is well established that the mere fact that something is "well-known" cannot serve as a substitute for motivation. See *In re Sponnovle*, 160 USPQ 237, 243 (CCPA 1969) (emphasis added) ("a patentable invention, within the ambit of 35 U.S.C. §103, may result even if the invention has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use."); also see *In re Warner*, 154 USPQ 173, 177 (CCPA 1967) which establishes that the question is never simply what is old; rather, the question is the obviousness of bringing the elements claimed in combination together. Accordingly, merely asserting that particular features of the claims are "old" or "well-known" in the art does nothing to establish a reason why one of ordinary skill would have been led to combine such features and, thus, does not inherently establish obviousness.

Moreover, according to the Examiner on page 5 of the Office Action, "[o]ne of ordinary skill in the would have found it obvious to use the electro-optical device of Erfinder in Willner et al and/or Yasmashita et al since, the fibers and lens structures are integral parts of the connector, which permits inexpensive mass production of the lens connector." The Examiner has failed to specify, however, the source of the motivation set forth in this assertion. Rather, only a conclusory statement is provided without the support of concrete evidence. Therefore, a proper *prima facie* case of obviousness has not been set forth and the rejection should be withdrawn.

If the origin of teachings and motivation set forth for the Examiner's statements and proposed combinations exists in the references then the Applicants request that this origin be set forth by the Examiner as suggested by MPEP 2144.08 III which states, "[w]here applicable, the finding should clearly articulate which portions of the reference support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. Dillon, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings." (Emphasis added).

If, however, the Examiner is relying on the personal knowledge of the Examiner, pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit

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that: (i) specifically identifies any and all references(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 1-13 and 15-26 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 1-13 and 15-26.

If the Examiner is relying on the applicant's teachings as the source of the proposed motivation/suggestion, then the Examiner is engaging in impermissible hindsight reconstruction of the Applicant's claims and the rejection is again improper.

In addition, the Examiner asserts on page 5 of the Office Action that the "applicant has not described such optical free-beam connection as being critical or yielding unexpected benefits." By this statement, it appears that the Patent Office is trying to shift the initial burden for providing a *prima facie* case of obviousness to the Applicant. The Applicant notes that it is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims and includes the required motivation for the combination of references. MPEP 2142 (emphasis added). It is not the Applicant's initial burden to specify a "criticality" for each and every element of each and every claim. Moreover, several of the benefits of the Applicant's claimed embodiments are set forth throughout the specification.

Moreover, the Examiner states on page 5 of the Office Action that "[c]ertainly a person of ordinary skill in the art would find it beneficial to achieve such electro-optical module if desired." Again, the Applicant respectfully requests identification of a source for this statement. As discussed above, if the source is in the references, the Applicant requests that this origin be set forth by the Patent Office as suggested by MPEP 2144.08 III. If the source for this statement is in the Examiner's personal knowledge, the Applicant requests an Examiner affidavit pursuant to 37 C.F.R. 1.104(d)(2) that: (i) specifically identifies any and all references(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 1-13 and 15-26 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 1-13 and 15-26. If the source is in the Applicant's teachings then the statement is based on impermissible hindsight and should be retracted.

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For these reasons, as well as others, the rejection of claims 1-13 and 15-26 should be withdrawn.

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CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 8 day of June, 2006.

Respectfully submitted,



DAVID A. JONES
Registration No. 50,004
Attorney for Applicant
Customer No. 022913
Telephone: (801) 533-9800

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